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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,733	01/07/2004	Norman H. Margolus	11656-004009	4737
26161	7590	01/22/2008		
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER EHICHIOYA, FRED I	
			ART UNIT 2162	PAPER NUMBER
			MAIL DATE 01/22/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/752,733

Applicant(s)

MARGOLUS, NORMAN H.

Examiner

Fred I. Ehichioya

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 111 - 113, and 167 - 177 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 111 - 113, and 167 - 177 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/25/07, 10/31/07.

- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.
2. Claims 111 - 113, and 167 - 177 are pending in this Office Action.

### ***Remarks/Response to Arguments***

3. Examiner submits that the current amendment to the claims of the instant application does not change the scope of the invention. Therefore, the rejection of last Office Action that is applicable herewith is proper.

Further review of the instant application and Application No. 10/752,838 shows that these inventions fall within the same environment except the omitting of the limitation "testing for whether the data item is already stored in the repository by comparing digital fingerprint of the data item to digital fingerprints of data already in the repository; and making a high speed connection between the application server and the data repository" from Application No. 10/752,838, it would have be obvious that these applications still achieve the same purpose. Therefore, this warrants a double patenting rejection between instant application and Application No. 10/752,838.

### ***Claim Objections***

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claim 166 is not included in the presented claims.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 111 – 113, and 167 - 177 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **Application No. 10/752,838**. The mapping of the similar claims is as following:

Instant Application <b>10/752,733</b>	Application No. <b>10/752,838</b>
111	164

Claim 164 of the Application No. **10/752,838** recites all the elements of claim 111 of the instant application. Although the conflicting claim is not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to exclude the term "testing for whether the data item is already stored in the repository by comparing digital fingerprint of the data item to digital fingerprints of data already in the repository; and making a high speed connection between the application server and the data repository" from Application No. 10/752,838 because the person would have realized that the remaining elements would have performed the same functions as before. "Omission of element and its function in

combination is obvious expedient if the remaining elements perform same functions as before." See *In re Karlson* (CCPA) 136 USPQ 184, decide Jan 16, 1963, Appl. No. 6857, U.S. Court of Customs and Patent Appeals.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 111 – 113, and 167 - 176 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 6,636,953 issued to Yuasa et al., (Hereinafter "Yuasa") in view of US Pub. No. 2002/0129168 issued to Kanai et al., (Hereinafter "Kanai").

Regarding claim 111, Yuasa teaches a method by which a client connected to a data repository over a lower speed network connection may provide higher speed access to a data item for application processing by an application server than is possible over the relatively low speed connection to the network (see column 40, lines 13 – 21), the method comprising:

assigning an expiration time to the data item (see column 23, lines 60 – 62), before which time both modification and deletion are prohibited (see column 13, lines 10 – 11); and

making a higher speed connection between an application server and the data repository (see column 40, lines 18 – 21).

returning a result of the execution step to the client across the lower speed connection (column 40, lines 11 – 21).

wherein the client reassigns the expiration time to a later time but no action taken by the client can cause the expiration time to be changed to an earlier time or cause the data item to be deleted at an earlier time than the expiration time (column 9, lines 13 – 15); and

wherein after the expiration time has passed deletion of the data item is allowed (column 9, lines 17 – 18).

Yuasa does not explicitly teach digital fingerprint as claimed.

Kanai teaches determining a digital fingerprint of the data item (page 12, [0209]: “a method for checking the data corresponding to the fingerprints recorded in the log table”);

testing for whether the data item is already stored in a repository by comparing the digital fingerprint of the data item to digital fingerprints of data items already in the repository (page 16, [0280]: “checks whether the data having this fingerprint name exists in the fingerprint cache 234 or not”);

only if the data item is not already in the repository, transferring the data item over the lower speed connection from the client to the repository (page 16, [0280]: “checks whether the data having this fingerprint name exists in the fingerprint cache 234

or not. Here it does not exist, so that it is the first time data and this data is entered (registered) into the fingerprint cache”);

executing an application on the application server to process the data item stored on the data repository (page 6, [0101] “when the data (such as reply data) are to be transferred from the server side proxy 230 to the client side proxy 240 by using the HTTP protocol, the server side proxy 230 calculates the fingerprint of that data, and if the data corresponding to that fingerprint exists in the fingerprint cache, it implies that (data with the same content as) this data had been transferred in the past”); and

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Kanai’s teaching of “digital fingerprint” would have allowed Yuasa’s system to monitor the authenticity of data transmitted. The motivation is that data integrity is preserved.

Regarding claim 112, Yuasa teaches the data repository comprises a plurality of storages sites (see Fig.4 step 2007 and column 39, lines 13 – 14) and rules governing expiration and deletion are distributed to the plurality of storage sites as part of the process of storing data items (see column 4, lines 11 – 20).

Regarding claim 113, Yuasa teaches the expiration time initially assigned to the data item depends upon an expiration time assigned by the client (see column 13, lines 10 - 14).



Regarding claim 167, Yuasa teaches the data repository is a disk-based data storage system (see column 9, lines 61 – 63).

Regarding claim 168, Kanai teaches the application server is separate from and independent of the data repository, and is connected to it by the network (see page 6, [0101]).

Regarding claim 169, Kanai teaches the digital fingerprint is a cryptographic hash of the content of the data item (see page 6, [0099]).

Regarding claim 170, Kanai teaches the data item is encrypted using a key based on the content of the data item (see page 6, [0090]).

Regarding claim 171, Kanai teaches the method of claim 111 in which the result of the executing step is returned to the client via a Web browser (see page 6, [0091]).

Regarding claim 172, Kanai teaches the client has a plurality of data items stored in the data repository and the client controls which of the plurality of data items the application server is allowed to access (see page 1, [0007]).

Regarding claim 173, Kanai teaches the method of claim 172 in which the client is a program running on a computer and the plurality of data items are copies of data items that reside in the storage of the computer, and the application server detects a problem in the configuration of the computer, based on the plurality of data items (see page 5, [0088]).

Regarding claim 174, Kanai teaches the method of claim 111 in which the client ensures that the data item is stored in the data repository in order to provide an archival record of data stored on a storage device that is local to the client (page 17, [0304]).

Regarding claim 175, Yuasa teaches the method of claim 174 in which the data item is time stamped in a manner that allows both its contents and the time it was created to be proven (column 16, line 61 – column 17, line 3).

Regarding claim 176, Yuasa teaches the method of claim 111 in which, after the expiration time has passed, the client deletes the data item (see column 9, lines 17 – 18).


Regarding claim 177, Kanai teaches the method of claim 111 in which the data item is communicated to a client via a Web browser (see page 6, [0091]).

**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jean Marie Ehichioya  
Primary Examiner  
TC 2100

/Fred I. Ehichioya/

January 18, 2008